

Response to § 103 Rejection

The Office rejects claims 1-18, 21, and 101-104 as unpatentable under 35 U.S.C. § 103(a) over (1) European Patent No. EP 0874017 ("Dalle") taken with *The Science of Hair Care*, pp. 68-70 (1986) ("Zviak"), or alternatively (2) claims 1-17, 19, 20, 22, 24, and 101-104 over *Dalle* in view of U.S. Patent No. 4,237,243 to *Quack et al.* ("Quack"), or alternatively (3) claims 1-19, 22, 23, 25-36, and 101-104 over *Dalle* in view of U.S. Patent No. 6,166,093 to *Mougin et al.* ("Mougin"), for the same reasons as set forth in the previous Office Action.

The Office rejects claims 37-63 under 35 U.S.C. § 103(a) as unpatentable over *Dalle* and *Mougin* in further view of U.S. Patent No. 6,039,936 to *Restle et al.* ("Restle"), for the same reasons as set forth in the previous Office Action.

Finally, the Office rejects claims 64-100 under 35 U.S.C. § 103(a) as unpatentable over *Dalle* and *Mougin* in view of U.S. Patent No. 6,150,311 to *Decoster et al.* ("Decoster"), for the same reasons as set forth in the previous Office Action.

Applicants respectfully traverse these rejections for the reasons of record and those which follow.

To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See M.P.E.P. § 2143. Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. See *In re Vaeck*, 947 F.2d 488, 20

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USPQ2d 1438 (Fed. Cir. 1991). See also *In re Dembicza*k, 50 USPQ2d 1614 (Fed. Cir. 1999) (requiring a “clear and particular” suggestion to combine prior art references).

In the present case, Applicants respectfully submit that there is no clear and particular motivation to combine the teachings of the cited documents, for at least the reasons discussed in Applicants’ May 7, 2002 Reply. For instance, the Office alleges that the incentive for combining *Dalle* with *Zviak*, *Quack*, or *Mougin* lies in the expectation to have produced compositions with desired viscosity. (Office Action dated May 9, 2001, page 4, lines 14-17; page 5, lines 10-13; page 6, 15-18.). There is, however, not even a remote suggestion in *Dalle* that one skilled in the art would desire to make adjustments to *Dalle*’s method to alter viscosity, nor has the Office alleged any such suggestion exists in *Dalle*.

Furthermore, there would have been no motivation to combine the relied on teachings of *Dalle* and *Quack*. In this regard, the Office relies on the silicone emulsion cosmetic teachings of *Dalle*. In contrast, *Quack* discloses a “silicon oil emulsion” in furniture polish, (col. 15, lines 39-44). In fact, Applicants are unaware of any other teaching in *Quack* regarding a “silicon oil emulsion.” *Quack* therefore fails to disclose or suggest that its teachings are applicable to cosmetics comprising silicone emulsions. Therefore, there would have been no motivation to combine the relied on teachings of *Dalle* and *Quack*.

In response to Applicants’ arguments that addressed the lack of a “clear and particular” reason to combine the references for each ground of rejection, the Office simply “respectfully disagrees for the reasons of record.” See Final Office Action at page 3. Applicants respectfully submit that the Office’s response is improper, and

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submit that "in making a final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated." MPEP §706.07. Moreover, the final grounds of rejection "must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal." *Id.*

Here, Applicants respectfully submit that the Office has not met this duty because the Office has failed to specifically address Applicants' arguments regarding "clear and particular" motivation. The Office has not set forth any substantial evidence of a clear and particular motivation to combine the references. Rather, it appears that the Office is circumventing Applicants' arguments, and the applicable law, by using the references to piece together the present invention in hindsight.

Moreover, the Federal Circuit recently reaffirmed the Examiner's high burden to establish a *prima facie* case of obviousness and emphasized a requirement for specificity. In *In re Lee*, the Federal Circuit held that "[t]he factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with." 277 F.3d 1338, 1433 (Fed. Cir. 2002). Further, the Federal Circuit explained that

[t]he need for specificity pervades this authority... the examiner can satisfy the burden of showing obviousness of the combination only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

Id. (internal citations and quotation omitted) (emphasis added). In view of *In re Lee*, the Office has failed to demonstrate a motivation to combine the references.

In response to the Office's statement regarding "analogous arts" on page 4 of the Final Office Action, Applicants respectfully submit that this statement is overly broad and irrelevant. This statement is irrelevant because Applicants never argue that the prior art is non-analogous. This statement is overly broad because, if you follow this flawed logic, any composition containing known cosmetic components would be unpatentable.

For at least these reasons, Applicants respectfully submit the Office is incorrect in maintaining the § 103 rejections as a matter of law. Applicants therefore respectfully request that this ground of rejection be withdrawn.

Conclusion

Applicants respectfully request reconsideration of this application and the timely allowance of all pending claims.

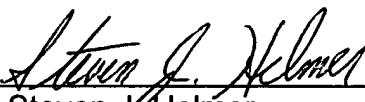
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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